

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 17, 2006. At the time of the Office Action, Claims 1-4, 15-23, 25-27, 40-42 and 52-71 were pending in this Application. Claims 1-4, 15-23, 25-27, 40-42 and 52-71 were rejected. Claim 5-14, 24, 28-39 and 43-51 were previously cancelled. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-4, 15-18, 40-42, 52-54, 63-67 and 69-71 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,929,238 issued to Baum (“Baum”). Applicant respectfully traverses this rejection.

Independent Claim 1 recites a high pressure applicator that includes, among other limitations a first column including “a first end and a second end having an orifice for delivering implant material therethrough”, and an intermediate section between said first and second ends …” and “said first column further comprising an introduction section commencing at said first end and adapted to hold said implant material, said introduction section having a different size than said intermediate section …”. Emphasis added.

Independent Claim 54 recites a high pressure applicator that includes, among other limitations, a first column including “a first end and a second end having an orifice for delivering implant material therethrough”, and an intermediate section between said first and second ends, said first column further comprising an enlarged introduction section commencing at said first end, said introduction section having a larger diameter than the intermediate section …”. Emphasis added.

Independent Claim 63 recites a high pressure applicator that includes, among other limitations, a first column having “a first end and a second end having an orifice for delivering flowable tissue implant material therethrough”, and an intermediate section between said first and second ends, said first column further comprising an enlarged introduction section commencing at said first end, at least a portion of the introduction section having a larger outside diameter

than the intermediate section for introducing flowable tissue implant material therein...”.
Emphasis added.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The office action contends that reference numeral 16 in figures 5 and 6 of Baum discloses “an introduction section commencing at the first end and adapted to hold implant material, the introduction section having a different size than the intermediate section...”. Emphasis added.

The Baum reference is generally directed to “an injector having utility in angiography and/or angioplasty applications, and capable of delivering fluid at multiple selected pressures.” Col. 1, lines 6-9. As such, Applicants submit that Baum fails to teach a high pressure applicator for introducing tissue implant material as recited in Claims 1, 54 and 63.

While Baum does disclose a column with a first (distal) end and a second (proximal) end, where the second end includes an orifice for delivering the implant material to a connected discharge tube, the second end of the injection device disclosed by Braum clearly does not include an introduction section as claimed. See Figures 5 and 6. Instead, the inner diameter of the injection system of Braum is uniform from the first (proximal) end and through the body of the column, until reaching the distal (second) end. Also, notably, reference numeral 16 of Baum cited in the office action is directed to a rotatable connector and not to an introduction section. Further, element 16 is located at the distal (second) end of the device, which also houses the exit orifice of the injector. In other words, both elements (the orifice and the introduction section) cited in the office action are located on the same (distal) end of the Baum device. Accordingly, Baum does not anticipate a first column in which an introduction section is provided at a first end and an orifice for delivering material therethrough is provided at the second end.

For at least these reasons, Applicants submit that Baum fails to disclose, teach or suggest each and every element of Independent Claims 1, 54 and 63. Applicants request reconsideration, withdrawal of the rejections under §102 and full allowance of Claims 1, 54 and 63 and Claims 4, 15-18, 40-42, 52-53, 64-67 and 69-71 which depend therefrom.

Rejections under 35 U.S.C. §103

Claims 20-23 and 25-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of U.S. Patent No. 4,863,072 issued to Perler (“Perler”). Claims 19 and 68 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of U.S. Patent No. 4,032,118 issued to Phillips (“Phillips”).

Applicant respectfully traverses and submits that the Claims rejected under §103 depend from claims that are in condition for allowance, as discussed above. Additionally, Applicants submit that the proposed combinations, even if proper (which Applicant does not concede), does not render the claimed embodiment of the invention obvious. For example, Perler and Phillips also do not disclose, teach or suggest an introduction section as recited, as discussed above with respect to Baum. In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Accordingly, Applicant submits that the proposed combinations of Baum with Perler or Phillips cannot render obvious Claim 20-23, 25-27, 19 and 68. Applicant requests reconsideration, withdrawal of the rejections under §103 and full allowance of Claims 20-23, 25-27, 19 and 69.

Information Disclosure Statement

Applicant would like to bring to the Examiner’s attention that Applicant filed an Information Disclosure Statement on April 1, 2002. Applicants respectfully request that the Information Disclosure Statement be considered and cited in the examination of the above-referenced application. Applicant attaches a copy of the Information Disclosure Statement and PTO Form 1449 filed April 1, 2002, for the Examiner’s convenience and a copy of the postcard receipt evidencing receipt by the Patent Office.

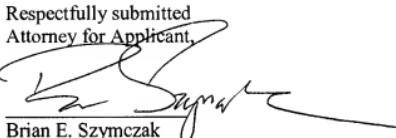
CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Aside from the two-month extension of time, Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.391.3961.

Respectfully submitted
Attorney for Applicant,



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Reg. No. 47,120

Date: 3/19/2007

SEND CORRESPONDENCE TO:

ARTHROCARE CORPORATION

CUSTOMER NO. **21394**

512.391.3961

512.391.3901 (fax)

Enclosure: 1) A copy of the Information Disclosure Statement and PTO Form 1449 filed April 1, 2002, and a copy of the postcard receipt.